

REMARKS

Claims 40-59 were pending in this application.

Claims 40-59 have been rejected.

Claim 54 has been amended as shown above.

Claims 40-59 remain pending in this application.

Reconsideration and full allowance of Claims 40-59 are respectfully requested.

I. OBJECTION TO SPECIFICATION

The Office Action objects to the specification as containing inaccurate continuity information. In particular, the Office Action asserts that this patent application does not contain the same disclosure as its parent application, U.S. Patent Application Serial No. 09/032,830. The Applicant has amended the specification to recite that this application is a continuation-in-part of its parent application. Accordingly, the Applicant respectfully requests withdrawal of the objection to the specification.

II. OBJECTION TO OATH/DECLARATION

The Office Action objects to the originally filed declaration because this application presents a claim for subject matter not originally claimed or embraced in the statement of the invention (namely, the use of a laser). The Applicant is attempting to obtain a signed Supplemental Declaration from the inventor and will submit the signed Supplemental Declaration or a Petition

Under 37 C.F.R. § 1.47(b).

III. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 54-59 under 35 U.S.C. § 102(b) as being anticipated by Sand. The Office Action rejects Claims 40-59 under 35 U.S.C. § 102(b) as being anticipated by March et al., “Safety of High-Energy Neodymium:YAG Laser Pulses in YAG Sclerostomy” (“*March*”). These rejections are respectfully traversed.

A prior art reference anticipates a claimed invention under 35 U.S.C. § 102 only if every element of the claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (*Fed. Cir.* 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (*Fed. Cir.* 1985)).

As an initial matter, the Office Action does not specify the patent number of Sand. The Applicant assumes that the Office Action rejects Claims 54-59 as being anticipated by U.S. Patent No. 4,976,709 to Sand (“*Sand*”). However, the Applicant respectfully requests clarification of this rejection in the next Official communication.

Regarding *Sand*, Claim 54 has been amended to recite “operating [a] laser to irradiate [a] sclera to increase an effective working distance of a ciliary muscle of the eye.” *Sand* is directed to a method for shrinking collagen to support applications such as corneal reshaping. (*Abstract*). While

Sand makes various references to the sclera of the eye, *Sand* never discloses irradiating the sclera to “increase an effective working distance of a ciliary muscle of the eye.” As a result, *Sand* fails to anticipate all elements of Claim 54 (and its dependent claims).

For these reasons, *Sand* fails to anticipate the Applicant’s invention as recited in Claims 54-59.

Regarding *March*, Claim 40 recites irradiating a sclera of an eye “to thereby weaken the sclera of the eye and increase an effective working distance of a ciliary muscle of the eye.” Claim 47 recites irradiating a sclera of an eye “to increase an effective working distance of a ciliary muscle of the eye.” Claim 54 recites operating a laser to irradiate a sclera of an eye “to increase an effective working distance of a ciliary muscle of the eye.”

March recites a technique for using laser pulses to form a “new channel for drainage of aqueous humor” in order to treat glaucoma. (*Page 584, Left column, Introduction*). The Office Action asserts that the new channel is formed by removing a portion of the sclera “in the region of the ciliary body.” The Office Action also asserts that *March* inherently leads to an increase in the “effective working distance” of the ciliary muscle of the eye because of the “laws of physics.” According to the Office Action, removing a portion of the sclera to form the “new channel” in *March* would inherently weaken the sclera. The Office Action then states that since the sclera is weaker, “this necessarily requires that the structure will expand due to the internal pressure thereof in combination with [its] weakened state. This expansion will also necessarily cause the effective working distance of the ciliary muscle to increase.” (*Office Action, Page 2, First paragraph – Page*

3, *Last paragraph*).

In effect, the Office Action is asserting that *March* inherently weakens the sclera, this weakening would inherently cause scleral expansion, and this scleral expansion would inherently increase the effective working distance of the ciliary muscle.

To establish inherency, the burden is on the Patent Office to present evidence clearly showing that “the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” (*MPEP* § 2112). However, the fact that a “certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” (*MPEP* § 2112). The Patent Office must “provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows” from the teachings of cited reference. (*MPEP* § 2112).

Figure 6 in *March* indicates that a fistula (the new channel) is formed at or near the Schlemm’s canal in the eye. It appears that this is located near the ciliary body of the eye. To that extent, *March* does disclose the use of a laser treatment near the ciliary body. However, the remaining assertions of inherency regarding *March* in the Office Action are unfounded and actually contradicted by the express statements in *March*.

The laser treatment of *March* is intended to lower intraocular pressure. *March* creates the new channel in the eye to allow aqueous humor from the interior of the eye to escape, thereby lowering intraocular pressure in the interior of the eye. Clearly, using the treatment of *March* would lower the internal pressure applied to the sclera of the eye, not increase that pressure. This lower pressure

would have the opposite effect as asserted in the Office Action.

The entire basis for this § 102 rejection is that *March* inherently discloses weakening the sclera and that the internal pressure of the eye would cause the weakened sclera to expand. However, *March* clearly discloses that its laser treatment procedure is designed to lead to lower internal pressure in the eye. This lower internal pressure would lead to less pressure being applied to the sclera of the eye. Rather than weakening the sclera and causing scleral expansion, the treatment disclosed in *March* would result in lower pressure on the sclera and likely result in scleral contraction or no movement at all.

The Office Action fails to explain how lowering the internal pressure in a patient's eye would inherently lead to expansion of the sclera. Referring to the "laws of physics" is not adequate in this case. It is inadequate to simply argue that something might occur in *March*. The burden is on the Patent Office to show that *March* must inherently lead to scleral expansion and that this must inherently lead to an increase in the effective working distance of the ciliary muscle. The Patent Office has not and cannot make this showing. *March* never once refers to causing scleral expansion or increasing the effective working distance of the ciliary muscle. *March* also lowers intraocular pressure, thereby lowering the pressure on the sclera (and contradicting the Office Action's claim that *March* inherently causes scleral expansion).

For these reasons, *March* fails to anticipate the Applicant's invention as recited in Claims 40, 47, and 54 (and their dependent claims).

Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejections and full

allowance of Claims 40-59

IV. DOUBLE PATENTING REJECTION

The Office Action rejects Claims 40-59 under the judicially created doctrine of obviousness type double patenting in view of four U.S. patents. The Applicant has included Terminal Disclaimers to overcome the double patenting rejections. Accordingly, the Applicant respectfully requests withdrawal of the double patenting rejections.

V. CONCLUSION

The Applicant respectfully submits that all pending claims are in condition for allowance and respectfully requests full allowance of all pending claims.

SUMMARY

If any issue arises, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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